

REMARKS/ARGUMENTS

The Invention

The present invention relates generally to implementing a Wireless Access Protocol (WAP) push and specifically to a system and a method for transmitting a Session Initiation Request. The claimed subject matter includes establishing a connection oriented signalling channel over which to send the SIRs. An example of a connection oriented signalling channel is the USSD channel in GSM based networks. This provides a faster delivery of an SIR to the mobile. Furthermore, the problem of backed up SIRs can be avoided as the connection oriented nature of the channel means that if the mobile does not establish a USSD or similar connection, the push application can be notified and stop sending SIRs until a USSD connection can be established. Once an SIR is delivered in this way, the mobile then activates a suitable bearer (e.g., GPRS PDP context) with which to establish the push session. Thus, in the absence of a suitable bearer for SIR signalling, the claimed subject matter provides a connection oriented solution which aims to overcome the above mentioned problems with the connectionless SMS method.

Status of the Claims

Claims 1-31 are pending in the application.

Claims 1, 3-4, 10, 11, 12, 14, 18-19, 20, 23, 28, and 29-31 are rejected under 35 U.S.C. § 103(a) as being unpatentable over WAP Push Architectural Overview (WAP-250-PUSHARCHOverview-20010703-p), in view of *Lewontin* (U.S. Patent Publication No. 2005/0071419 A1), further in view "Over the Air Over HTTP".

Claims 2, 12, and 21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over PUSHARCH, in view of *Lewontin* (U.S. Patent Publication No. 2005/0071419 A1) and OTAHTTP, as applied to Claims 1, 11 and 20, and further in view of *Iivari et al.* (U.S. Patent Publication No. 2005/0020234 A1).

Claims 6-8, 15-17 and 25-27 are rejected under 35 U.S.C. § 103(a) as being unpatentable over PUSHARCH, in view of WAP Over GSM USSD (WAP-204-WAPOverGSMUSSD-20010730-a) as applied to Claims 1, 11 and 20.

Claims 5 and 24 are rejected under 35 U.S.C. § 103(a) as being unpatentable over PUSHARCH, *Lewontin* (U.S. Patent Publication No. 2005/0071419 A1) and ATAHTTP, as applied to Claims 1 and 20, in view of Push OTA Protocol (WAP-235-PUSHOTA-20010425-a).

Claim 9 is rejected under 35 U.S.C. § 103(a) as being unpatentable over PUSHARCH, *Lewontin* (U.S. Patent Publication No. 2005/0071419 A1), OTAHTTP and WAPU as applied to Claims 6 and 8 and further in view of *Livari et al.* (U.S. Patent Publication No. 2005/0020234 A1).

Claims 13 and 22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over PUSHARCH, in view of *Lewontin* (U.S. Patent Publication No. 2005/0071419 A1), OTAHTTP, and WAPU, as applied to Claim 20, and further in view of PUSHOTA.

Claim Rejections 35 U.S.C. 103

Claims 1, 3-4, 10, 11, 12, 14, 18-19, 20, 23, 28, and 29-31; Rejected under 35 U.S.C. § 103(a)

Claims 1, 3-4, 10, 11, 12, 14, 18-19, 20, 23, 28, 29-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over WAP Push Architectural Overview (WAP-250-PUSHARCHOverview-20010703-p), hereinafter PUSHARCH, in view of *Lewontin* (US 20050071419 A1), herein after *Lewontin*, further in view of "Over the Air over HTTP," hereinafter OTAHTPP.

Claim 1

PUSHARCH teaches the conventional approach of sending a request via connectionless push to set up connection-oriented bearer for subsequent connection-oriented push. The Examiner concedes PUSHARCH does not disclose establishing a connection-oriented signalling channel for the purpose of transmitting the initiation request. The Examiner points to *Lewontin* in support of this, arguing that *Lewontin*:

“disclose[s] transmitting an initiation request to the mobile station by establishing a connection-oriented signalling channel between the network and the mobile

station (*Lewontin*: [0040], lines 7-9 describes establishing the connection oriented push)”

emphasis added.

This, however, is inconsistent with the Examiner’s own statement in the following paragraph (half way down the page on page 4) which reads:

“The combined teachings of PUSHARCH and *Lewontin* do not disclose using said channel to transmit said request”.

Thus, the Examiner himself concedes that *Lewontin* in fact does NOT disclose “transmitting an initiation request to the mobile station by establishing a connection-oriented signalling channel...”.

It is respectfully submitted that the relevance of *Lewontin* is substantially cumulative to that of PUSHARCH, at least for the subject matter relied upon by the Examiner. In particular, *Lewontin*, like PUSHARCH, teaches using a connection-oriented push to transmit push information to the mobile device. *Lewontin*, like PUSHARCH, does not teach “transmitting an initiation request to the mobile station by establishing a connection-oriented signalling channel...”. *Lewontin*, like PUSHARCH, teaches transmitting an SIR using connectionless push. For example see paragraph [0049] which reads:

“After receiving the SOAP request 308, the PPG 304 sends a session initiation request (SIR) 310 to the mobile terminal 302 via a connectionless push.”

Thus, the combination of *Lewontin* and PUSHARCH does not produce the result asserted by the Examiner. It should be clear that the combination of *Lewontin* and PUSHARCH together still teach a connectionless push of the SIR in combination with a subsequent connection oriented push of the content. On this basis, Applicant respectfully submits that the rationale for combining *Lewontin* and PUSHARCH set out by the Examiner on the second paragraph of page 4 of the detailed action is not valid. Specifically, the so-called “connection-oriented signalling channel” of *Lewontin* referred to by the Examiner is simply the channel used to perform the connection-oriented push of

the content, exactly what a similar channel is used for in PUSHARCH.

The Examiner has also argued that

“PUSHARCH implicitly teaches or does not exclude the transmission of SIR via connection oriented mode of push operations (PUSHARCH: section 8.3, the 3rd paragraph, line 1, “...the SIR is typically sent...”)

emphasis added.

With respect, the fact that something may not exclude something is completely different from implicitly teaching something. The Examiner cannot establish inherency merely by demonstrating that the asserted limitation is probable or possible. See *In re Oelrich*, 666 F.2d 578, 581 (CCPA 1981).

Turning now to OTAHTTP, slide 4 teaches:

“PPG sends an SIR to the terminal using either connectionless push over a bearer where a well-known address can be used (MSISDN for SMS), or by using connection-oriented push if applicable”.

This is expanded upon in slide 27 of OTAHTTP entitled “OTA-Session Initiation Request (1/2)” which reads:

“Push is async, it is possible that no push session or active TCP connection exist

PPG request SIR to SIA on Terminal to establish WSP session or TCP connection

SIR use connectionless or connection oriented push”

emphasis added. What are being described are two alternatives:

in a first case, there IS NO push session and no active TCP connection, and in that case, a connectionless push is used to transmit the SIR;

in a second case, there IS an active TCP connection, and in that case, a connection-oriented push is used to transmit the SIR.

In other words, OTAHTTP is yet another reference that does not teach “transmitting an initiation request to the mobile station by establishing a connection-oriented signalling channel between the network and the mobile station”. Rather, OTAHTTP teaches using a connection-oriented push if such a connection already exists, but otherwise teaches using a connectionless push with all its associated problems. There is absolutely no suggestion in OTAHTTP of establishing a connection-oriented signalling channel for the purpose of transmitting an SIR.

On this basis, applicant respectfully submits that the factual basis upon which the Examiner bases his obviousness rejection is flawed.

The law on obviousness under 35 U.S.C. 103 was recently addressed in *KSR International v. Teleflex, Inc.*, No. 04-1350, slip op. at 14 (U.S., Apr. 30, 2007). Following this, examination guidelines were released on October 10, 2007 in regards to determining obviousness under 35 U.S.C. 103. According to these guidelines, the framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.* 383 U.S. 1,148 USPQ 459 (1966). Obviousness is a question of law based on underlying factual inquiries. The factual inquiries enunciated by the Court are as follows:

- (1) Determining the scope and content of the prior art;
 - (2) Ascertaining the differences between the claimed invention and the prior art;
- and
- (3) Resolving the level of ordinary skill in the pertinent art.

The Graham factors, including secondary considerations when present, are the controlling inquiries in any obviousness analysis. Once the findings of fact are articulated, Office personnel must provide an explanation to support an obviousness

rejection under 35 U.S.C. 103. According to *KSR International*, for the Patent Office to properly combine references in support of an obviousness rejection, the Patent Office must identify a reason why a person of ordinary skill in the art would have sought to combine the respective teachings of the applied references.

On the basis of the above detailed discussion of the cited references, applicant respectfully submits that the Examiner has not properly determined the scope and content of the prior art for the reasons noted. Because of this, while the Examiner has provided an explanation to support the rejection, it is not supported by the content of the references.

Further, Applicant again notes that, with regard to the determination of obviousness under 35 U.S.C. § 103, the Supreme Court has stated that:

Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, *it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does*. This is so because inventions in most, if not all, instances rely on building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.

KSR International Co. v. Teleflex Inc., ___ U.S. ___, ___, 2007 WL 1237837 (2007), (Slip Opinion at 14-15) (emphasis added). In addition, the Supreme Court also noted that:

Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, *this analysis should be made explicit*. See *In re Kahn*, 441 F.3d 977, 988 (Fed Cir. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, *there must be some articulated reasoning with some rational underpinnings to support the legal conclusion of obviousness*”).

Id., at ___ (Slip Opinion at 14) (emphasis added). It is noted that the Supreme Court

included an extended discussion reciting the nature of the inventions disclosed in the prior art and then several paragraphs identifying the rationale and reasons that the cited art could be combined and why one skilled in the art would make such a combination. *Id.*, at ____ (Slip Opinion at 3-6, 20-22).

With regard to combining known elements of an invention, the Supreme Court further stated that, “[A] patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.” *Id.*, at ____ (Slip Opinion at 14). This holding comports with *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988), which held that, although some of the cited references individually may have some of the claimed inventions’ features, “one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to depreciate the claimed invention.” *Id.* at 1075. Instead, to reach the proper conclusion under §103:

The decision maker must step backward in time and into the shoes worn by [a person having ordinary skill in the art] when the invention was unknown and just before it was made. In light of *all* the evidence, the decision maker must then determine whether...the claimed invention as a whole would have been obvious at *that* time to *that* person.

Id. at 1073-74 (emphasis added).

In this Office Action, the Examiner has merely identified a series of selected elements (*e.g.*, [X and Y] from the cited art, and stated that, “it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate [X and Y].” There are at least two problems with this type of rejection: First, Applicant believes that such conclusory sentences is not sufficient to qualify as an “articulated reasoning with some rational underpinnings to support the legal conclusion of obviousness” and that the Examiner has failed to make the analysis explicit. This is an error. *See* MPEP §§ 2141, 2142, and 2143. Moreover, the Court in *KSR International* specifically states that a mere conclusory statements cannot sustain a determination of obviousness. Second, as set forth in *Fine*, merely identifying a list of elements and stating that they may be combined is not sufficient to support a rejection under 35 U.S.C. § 103(a).

The other independent claims rejected by the Examiner under 35 U.S.C. §103

include claims 11, 20, 29, 30 and 31. All of these claims also include the missing limitation referred to above and as such, it is respectfully submitted that these claims are patentable for the same reasons. Claims 3, 4, 10, 12, 14, 18, 19, 23, 28 all depend upon on of the above discussed independent claims and should be allowable for the same reasons. Applicant reserves the right to make further arguments in respect of the rejections raised by the Examiner against the dependent claims.

Accordingly, the rejection of Claims 1, 3-4, 10, 11, 12, 14, 18-19, 20, 23, 28, 29-31 under 35 U.S.C. §103(a) is in error and the rejection should be withdrawn.

Claims 2, 12, and 21; Rejected under 35 U.S.C. § 103(a)

Claims 2, 12, and 21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over PUSHARCH, in view of *Lewontin* (U.S. Patent Publication No. 2005/0071419 A1) and OTAHTTP, as applied to Claims 1, 11 and 20, and further in view of *Iivari et al.* (U.S. Patent Publication No. 2005/0020234 A1). These claims depend upon one of the above discussed claims 1, 11 and 20. The Examiner relies on the same combination of references PUSHARCH, *Lewontin* and OTAHTTP for their content expressed in respect of claims 1, 11 and 20 and further relies on *Iivari*. These claims should be patentable for the reasons presented previously.

Claims 6-8, 15-17 and 25-27; Rejected under 35 U.S.C. § 103(a)

Claims 6-8, 15-17 and 25-27 are rejected under 35 U.S.C. § 103(a) as being unpatentable over PUSHARCH, in view of WAP Over GSM USSD (WAP-204-WAPOverGSMUSSD-20010730-a) as applied to Claims 1, 11 and 20. The rejection raised by the Examiner in paragraph 15 of the Office Action is not understood. The Examiner refers to the combination of PUSHARCH in view of WAP Over GSM USSD, "as applied to claims 1, 11 and 20 above". It is noted that WAP Over GSM USSD was not applied to claims 1, 11 and 20. Furthermore, the Examiner has not cited *Lewontin* nor OTAHTTP in the rejection in paragraph 15. As such, many limitations of the claims are simply not addressed in the Examiner's discussion of these claims.

Applicant respectfully notes that these claims dependent upon one of the above discussed claims and as such should be patentable for the same reasons.

Applicant further notes that WAPU does not disclose using the USSD mechanism for SIR transmission. While the Examiner refers to Section 5.1 which refers to the use of USSD as transparent bearer, there is nothing that suggests that it would be used for setting up a connection-oriented medium for push operation. The Examiner argues it would be "obvious for one skilled in the art at the time of the invention to combine the teachings of PUSHARCH with the teachings of WAPU by explicitly including bearer surfaces, such as USSD by avoiding the store-and-forward procedures, to provide the capability for delivering real-time services". Again, Applicant is not suggesting that the use of bearer services for delivery of the push-data per se is new. Rather, Applicant is claiming the establishment and use of a connection oriented signaling channel for transmitting the request to initiate a push session. The motivation provided by the Examiner simply leads to the use of a USSD for transmission of the push data per se, and this is not what the claims are covering. Furthermore, Applicant respectfully submits that the Examiner's rationale for obviousness is conclusory. The Examiner has provided no basis for why a person skilled in the art would find it obvious to reason the conclusion set out by the Examiner.

Claims 5, 9, 13, 22 and 24; Rejected under 35 U.S.C. § 103(a)

Claims 5 and 24 are rejected under 35 U.S.C. § 103(a) as being unpatentable over PUSHARCH, *Lewontin* (U.S. Patent Publication No. 2005/0071419 A1) and ATAHTTP, as applied to Claims 1 and 20, in view of Push OTA Protocol (WAP-235-PUSHOTA-20010425-a). Claim 9 is rejected under 35 U.S.C. § 103(a) as being unpatentable over PUSHARCH, *Lewontin* (U.S. Patent Publication No. 2005/0071419 A1), OTAHTTP and WAPU as applied to Claims 6 and 8 and further in view of *Livari et al.* (U.S. Patent Publication No. 2005/0020234 A1). Claims 13 and 22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over PUSHARCH, in view of *Lewontin* (U.S. Patent Publication No. 2005/0071419 A1), OTAHTTP, and WAPU, as applied to Claim 20, and further in view of PUSHOTA.

The remaining 35 U.S.C. §103 rejections all rely upon the combination of PUSHARCH, *Lewontin* and OTAHTTP used in the rejection of claim 1, in combination with various other references. Applicant respectfully submits that these claims should be patentable for the same reasons presented above. Applicant reserves the right to make further arguments in respect of the content of the additional references cited by the Examiner.

The Examiner is respectfully requested to withdraw all of the 35 U.S.C. §103 rejections and to allow the application.

CONCLUSION

In view of the remarks above, Applicants respectfully submit that the application is in proper form for issuance of a Notice of Allowance and such action is requested at an early date.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'D. C. Jenkins', with a long, sweeping horizontal line extending to the right.

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